

Remarks/Arguments

This Amendment is in response to the Office Action taken October 10, 2007, regarding the above-identified U.S. Patent Application.

In that Action, the Examiner raised a technical punctuation objection with regard to claim 1, which objection has been addressed by the present Amendment, and rejected all pending claims in the application under 35 U.S.C. §103 on the basis of different applications of two prior art references, namely, Barrett et al., U.S. Patent No. 5,647,056, and Chou et al., U.S. Patent Application Publication No. 2003/0204950.

Applicant has carefully studied the Examiner's Action and comments, and the cited and applied prior art, and by the present Amendment, which makes modest changes in certain ones of the claims, and for the reasons stated below, asserts that applicant's claims as they now stand in this case, on the basis of entry of the present Amendment, are clearly distinguishable in all respects over the cited and applied art, and are therefore patentable.

In the Office Action, the Examiner utilizes the Barrett et al. reference as the principal reference on which to base claim rejections, but the Examiner has clearly misconstrued and misunderstood how different the Barrett et al. technology is in relation to Applicant's claimed methodology. More specifically, whereas Applicant's methodology for downloading to a client device, and therein auto-configuring, an imaging device driver is based solidly and pointedly on the utilization of information embedded within an imaging device's included firmware *per se*, the Barrett et al. reference is solidly based upon a very different technology which requires the utilization of an externally added circuit board structure for managing access by a client device to

a network peripheral. In other words, whereas applicant recognizes the opportunity to use imaging device embedded firmware to accomplish driver downloading and configuring, Barrett et al. does not, and instead, requires the introduction of an independent circuit board device wherein driver and configuration information is contained.

Nothing about Barrett et al. has anything to do with deriving utility from firmware information embedded in a peripheral imaging device *per se*. Accordingly, the Barrett et al. approach is more complex and costly than the approach taken by applicant, and classically presents an historically understood patentable difference between this cited art and applicant's claims, which do not require the presence of any additional hardware.

Lest the Examiner be uncertain about this dramatic difference between Barrett et al. and applicant's claims, the Examiner is encouraged to take a careful re-look at the text of the Barrett et al. reference, wherein discussion therein is replete with references to the utilization of and need for an extra, independent circuit board structure. In point of fact, the specification statement in Barrett et al. regarding Field of Invention opens with the statement "The present invention relates generally to *a circuit board which is coupled to a local area network peripheral...and which allows the peripheral to be an intelligent interactive network member...*" (Emphasis Added). Further, in column 2 of the Barrett et al. specification, the inventors state "...the present invention comprises a method and apparatus for managing access to a peripheral on a local area network *by means of an interactive network board connectable to the peripheral via a peripheral interface and connectable to the local area network via a network interface.*" (Emphasis Added).

It is therefore unmistakable that Barrett et al. does not appreciate anything about the opportunity utilized and claimed by applicant regarding employing peripheral embedded firmware *per se* as a source for managing of access between that peripheral and a client device. Not only, therefore, is Barrett et al. a significantly deficient reference on its face, it clearly is not properly modifiable in any way to remove its asserted important dependence on the adding of special hardware which is outside of, and independent from, a peripheral network device, such as an imaging device.

While applicant's originally presented claims, read in light of applicant's specification, clearly distinguish applicant's claimed invention from what is shown or suggested in Barrett et al., in order to make the differentiation which truly characterizes applicant's invention more distinct, claims 1, 8, 13 and 16 have been modestly amended to emphasize the meaning of the word "embedded" originally presented in those claims. More specifically, current amendments in these four claims make unmistakably clear that the embedded information utilized in the practice of applicant's invention is resident within the firmware *per se* of a network imaging device. This language can in no way be said to read upon, or to be made obvious, by a disclosure in the prior art which rests on the concept of adding additional hardware in order to accomplish peripheral device management.

Apart from these modest clarifying changes made in the four independent claims in this application, all other claims remain as original claims.

Because of the serious deficiency present in the Barrett et al. reference which highlights dramatically why applicant's claimed invention is patentable, there is nothing about the

companion Chou et al. reference which in any way mends this deficiency.

Accordingly, for the reasons stated above, applicant asserts that all claims now presented in this application, on the basis of entry of the present Amendment, are in conditions for immediate allowance, and favorable reconsideration of this application, and immediate allowance of all pending claims, are therefore respectfully solicited. If the Examiner has any questions regarding the amendment or remarks, the Examiner is invited to contact Attorney-of-Record Jon M. Dickinson, Esq., at 503-504-2271.

Provisional Request for Extension of time in Which to Respond

Should this response be deemed to be untimely, Applicants hereby request an extension of time under 37 C.F.R. § 1.136. The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any over-payment to Account No. 22-0258.

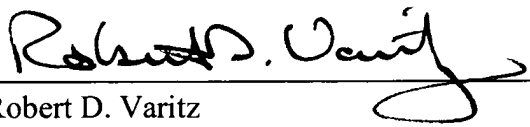
Customer Number

55428

Respectfully Submitted,

ROBERT D. VARITZ, P.C.

Registration No: 31436
Telephone: 503-720-1983
Facsimile: 503-233-7730


Robert D. Varitz
4915 S.E. 33d Place
Portland, Oregon 97202



CERTIFICATE OF EXPRESS MAILING

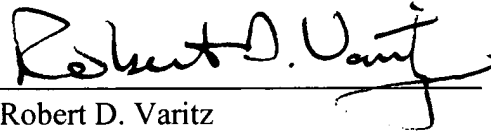
"Express Mail" Mailing Label No.

Date of Deposit - January 2, 2008

EM088410294US

I hereby certify that the attached Response to Office Action under 37 C.F.R. § 1.111 is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 on the date indicated above and is addressed to:

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Washington, D.C. 22313-1450


Robert D. Varitz